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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/576,512	04/20/2006	Akira Matsuki	09812.0757	3760		
22852	7590	03/30/2010	EXAMINER			
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				RUTLEDGE, AMELIA L		
ART UNIT		PAPER NUMBER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/576,512	MATSUKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	AMELIA RUTLEDGE	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 December 2009.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12/22/2009</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. This action is responsive to the following communications: Amendment, filed 12/22/2009; Information Disclosure Statements, filed 12/22/2009.
2. Claims 1-5 are pending. Claims 1 and 5 are independent claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Iseki et al., ("Iseki") U.S. Pub. No. 2002/0007311 A1, published January 2002, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iseki.**

**Regarding independent claim 1, Iseki teaches a mobile recording medium manufactured specifically for a place by a company for creating an original electronic album of the place, the mobile recording medium comprising:**

*material information provided by the company that is pre-recorded on the recording medium, the material information including at least one of text, an image, audio, and a map relating to the place; because Iseki teaches a system for creating a digital album of a place, including video, audio, and image data from a digital video camera (par. 0034-0036). Iseki teaches providing material information, including pre-recorded images and video of a place, by a travel company for creating the digital album (par. 0098-0101). Iseki teaches that the pre-recorded images are registered and stored (par. 0057-0059; par. 0089). Iseki teaches a mobile recording medium where a video camera acts as a terminal to store the registered images (par. 0097).*

*Iseki teaches a program which, when executed by a processor, causes a system to: receive situational information associated with information captured by a user, the situational information associated with the material information and including at least one of a location, a date, and a time relating to the place; because Iseki teaches that it is possible for a user to input a location, date and time, or alternatively, to fetch position and time information relating to the place and date from the camera used to pick up the image (par. 0058; par. 0056-0057; Fig. 13; Fig. 14).*

*Iseki teaches ...search the material information using the situational information; determine resulting material information, as a result of the search, because Iseki teaches that it is possible to input a location, date and time, or alternatively, to search position and time information relating to the place and date from the camera used to pick up the image (par. 0058; par. 0056-0057; Fig. 13; Fig. 14). Further, Iseki teaches*

searching stored situational information by allowing a user to retrieve image information based on name, place, or date (par. 84).

Even if Iseki did not explicitly teach that the mobile recording medium was manufactured specifically for a place by a company, since Iseki teaches that it is possible to give a function as a terminal to the digital camera, i.e., recording medium where position information and date information provided in the camera are used as the input information (par. 0095-0097), and Iseki teaches providing material information, including pre-recorded images and video of a place, by a travel company for creating a digital album (par. 0098-0101), it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the digital camera and/or storage medium to store the pre-recorded travel information, since it would have been obvious to combine the disclosed prior art elements of camera, storage, and pre-recorded images using the disclosed methods of using the camera as a terminal, in order to achieve predictable results (KSR).

**Regarding dependent claim 4**, Iseki teaches *an ID (identification number) wherein the ID enables the system to receive updates via a network for the mobile recording medium, thereby updating the recording medium with the newest material information*; because Iseki discloses an ID for images and the recording medium, for use for providing information and updates via a network, the internet (par 0035-0038; 0051; 0058-0060).

**Regarding independent claim 5**, Iseki teaches *an electronic album creating apparatus for creating an electronic album relating to a place, the apparatus comprising:*

*a first recording medium configured to store information captured by a user of the place and situational information associated with the information, the situational information including at least one of a location, a date, and a time of the place, wherein the situational information is either automatically recorded upon capture of the information or is provided by the user; because Iseki teaches a system for creating a digital album of a place, including video, audio, and image data from a digital video camera (par. 0034-0036). Iseki teaches providing material information, including pre-recorded images and video of a place, by a travel company for creating the digital album (par. 0098-0101). Iseki teaches that the pre-recorded images are registered and stored (par. 0057-0059; par. 0089). Iseki teaches a mobile recording medium where a video camera acts as a terminal to store the registered images (par. 0097).*

Iseki teaches that it is possible to input a location, date and time, or to fetch position and time information relating to the place and date from the camera used to pick up the image (par. 0058; par. 0056-0057; Fig. 13; Fig. 14).

*Iseki teaches a second recording medium manufactured specifically for the place by a company configured to store: material information provided by the company that is pre-recorded on the second recording medium, the material information including at least one of text, an image, audio, and a map relating to the place; because Iseki teaches that it is possible to input a location, date and time, or to fetch position and time information relating to the place and date from the camera used to pick up the image (par. 0058; par. 0056-0057; Fig. 13; Fig. 14).*

Iseki teaches a second recording medium because Iseki discloses an embodiment having a digital video camera connected with several terminals containing storage media storing text, image, and audio data, and situational information including a location, date, and time (par. 0036-0047). Iseki also teaches that it is possible to give a function as a terminal to the digital camera, i.e., recording medium where position information and date information provided in the camera are used as the input information (par. 0095-0097).

Iseki teaches *a program, which when executed by a processor of the apparatus, causes the apparatus to: search the material information stored on the recording medium using the situational information; determine and display resulting material information*; because Iseki teaches that it is possible to input a location, date and time, or alternatively, to search position and time information relating to the place and date from the camera used to pick up the image (par. 0058; par. 0056-0057; Fig. 13; Fig. 14).

Further, Iseki teaches searching stored situational information by allowing a user to retrieve image information based on name, place, or date (par. 84).

Even if Iseki did not explicitly teach that the mobile recording medium was manufactured specifically for a place by a company, since Iseki teaches that it is possible to give a function as a terminal to the digital camera, i.e., recording medium where position information and date information provided in the camera are used as the input information (par. 0095-0097), and Iseki teaches providing material information, including pre-recorded images and video of a place, by a travel company for creating a digital album (par. 0098-0101), it would have been obvious to one of ordinary skill in the

art at the time of the invention to have used the digital camera and/or storage medium to store the pre-recorded travel information, since it would have been obvious to combine the disclosed prior art elements of camera, storage, and pre-recorded images using the disclosed methods of using the camera as a terminal, in order to achieve predictable results (KSR).

**Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iseki in view of Renie, U.S. Patent No. 5,655,053, issued August 1997.**

**Regarding dependent claim 2,** Iseki suggests but does not explicitly teach a *plurality of opening videos*; because Iseki teaches that image information registered with an image provider can be extracted, and image and video information can be stored as both open registered and private, therefore allowing a user to retrieve a plurality of opening videos (par. 0089-0090; par. 0083-0084).

Renie teaches automatically inserting personalized opening video segments into pre-recorded stock footage of rides and attractions as well as other stock material on the tape such as special events, parades, etc. (col. 8, l. 6-31).

Both Renie and Iseki are directed to the recording and storage of image data. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system for producing customized video recordings for a sightseeing spot disclosed by Renie, with the image editing and storage system disclosed by Iseki, in order to allow users of the system flexibility in storing and accessing their recorded image content, as well as providing third party access to the content (Iseki, par. 0006).

**Regarding dependent claim 3**, while Iseki does not explicitly teach ...*wherein the system displays an opening video associated with the situational information*, Renie teaches automatically inserting personalized video segments into pre-recorded stock footage of rides and attractions as well as other stock material on the tape such as special events, parades, etc. (col. 8, l. 6-31).

Iseki teaches *wherein the system displays an opening video associated with the situational information and automatically displays, thereafter, images and the like prepared by the user in a chronological order*, because Iseki teaches an electronic service site for a digital album (par. 0035-0038), where situational information can be recorded with an image prepared by the user, and users can store their images in a digital album in chronological order (par. 0058; 0065; 0100; 0103).

Both Renie and Iseki are directed to the recording and storage of image data. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system for producing customized video recordings for a sightseeing spot disclosed by Renie, with the image editing and storage system disclosed by Iseki, in order to allow users of the system flexibility in storing and accessing their recorded image content, as well as providing third party access to the content (Iseki, par. 0006).

### ***Response to Arguments***

Applicant's arguments filed 12/22/2009 have been fully considered but they are not persuasive (see Remarks, p. 6-7). The newly claimed limitations of independent claims 1 and 5 are disclosed by Iseki as set forth in the claim rejections, above. Iseki

teaches providing material information, including pre-recorded images and video of a place, by a travel company for creating the digital album (par. 0098-0101). Iseki teaches that the pre-recorded images are registered and stored (par. 0057-0059; par. 0089). Iseki teaches a mobile recording medium where a video camera acts as a terminal to store the registered images (par. 0097).

In response to applicant's argument that the claimed "mobile recording medium" is "manufactured specifically for a place by a company..." (see Claim 1; Remarks, p. 6), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the video camera disclosed by Iseki is capable of performing the intended use.

A new grounds of rejection under 35 U.S.C. 103(a) as obvious over Iseki has also been applied to independent claims 1 and 5. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amelia Rutledge/  
Primary Examiner, Art Unit 2176